



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/897,076	07/18/97	MCGEENEY	NCI-1001

DAVID I ROCHE  
BAKER AND MCKENZIE  
ONE PRUDENTIAL PLAZA  
130 EAST RANDOLF DRIVE  
CHICAGO IL 60601

QM21/0515

EXAMINER
BLAU, S

ART UNIT	PAPER NUMBER
3/11	

DATE MAILED: 05/15/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/897,076

Applicant(s)

McGeeney

Examiner

Stephen Blau

Group Art Unit

3711



☒ Responsive to communication(s) filed on Jul 18, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-52 is/are pending in the application.

Of the above, claim(s) 23-52 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a golf club head, classified in class 473, subclass 341.
- II. Claims 23-52, drawn to a method of making a golf club head, classified in class 425, subclass 110.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of a golf club head and a method of making a golf club head are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a method a golf club head can be made by another process rather than molding as using adhesive or screws to secure the segments together.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Mr. David I. Roche on 29 April 1998 a provisional election was made without traverse to prosecute the invention of a golf club head, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-52 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Information Disclosure Statement***

6. The three pieces of other prior art listed on sheet 1 of 3 of the Information Disclosure Statement dated 7/18/98 were not considered due to a month not being provided for the first two listed and a month and a year not being provided for the third one listed which is required by article 609 (MPEP).

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***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-2 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Coughlin.

Coughlin discloses three discrete segments in a form that a body comprises a heel, toe and center sections being individually distinct due to shape and location (See enclosure (1)) including a heel formed of a first dense metallic material in a form of a heel weight formed of a copper alloy, a toe being formed of a second dense metallic material in a form of a toe weight formed of a copper alloy (Col. 2 Lns. 60-64), a center segment being formed of a non-metallic material in a form of a polycarbonate plastic (Col. 2 Lns. 39-45) having a density substantially less than metallic materials comprising a heel or a toe (Col. 2 Lns. 60-64), a heel, toe and center segment being joined together; a strike face extending across one side of said heel, toe, and center segment, a non-metallic material comprising said center segment being homogenous substantially

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entirely along at least one plane perpendicular to said strike face, wherein a non-metallic material has a homogenous composition (Col. 2 Lns. 39-45, enclosure (1)), and wherein a head being a putter-type head (Title).

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hussey.

Hussey discloses a head comprising three discrete segments in a form that a body comprises a heel, toe and center segments being individually distinct due to type of material including a heel being formed of a first dense metallic material in a form of metal, a toe being formed of a second dense metallic material in a form of metal, and a center segment being formed of a non-metallic material having a density substantially less than metallic materials comprising a heel or a toe in a form of a center segment being formed of wood, a heel, toe and center segment being joined together, and a strike face extending across one side of a heel, toe and center segment, a non-metallic material comprising a center segment being homogenous substantially entirely along at least one plane perpendicular to a strike face (Fig. 3, Col. 3 Lns. 53-67, Col. 5 Lns. 19-31, Col. 6 Lns. 47-50).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-8, 13-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughlin.

Coughlin discloses a first and second metallic materials each comprising at least two metals, a first metal dispersed in a matrix of a second metal, and a first metal having a higher density than a second metal in a form of brass or bronze (Col. 2 Lns. 60-64). In addition, Coughlin discloses having a heavy material as lead which has a density of at least 10 grams per cubic centimeter and steel or any other material (Col. 2 Lns. 60-64). Clearly an artisan skilled in the art of making heavy weights of material would have selected a suitable material which has a suitable density in which lead brass is included.

The differences between the claims and Coughlin are that Coughlin does not disclose a first and second metallic materials each having a final alloy density of at least 7 grams per cubic centimeter, a final alloy density of 7 to 13 grams per cubic centimeter, a final alloy density of 9 to 11 grams per cubic centimeter, a final alloy density of approximately 10 grams per cubic centimeter, a first metal having a density of at least 10 grams per cubic centimeter, and a second metal being selected from copper based alloys.

It would have been obvious to modify the head of Coughlin to have weights made of lead brass with a density as defined by the claims in order to weight a toe and heel more than by using

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just brass weights but less than by using just lead to accommodate the club head balance requirements of a specific player.

12. Claims 9-11 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughlin as applied to claims 3-8, 13-18 and 22 above, and further in view of LaCoste.

The difference between the claims and Coughlin is that Coughlin does not disclose a non-metallic material being made of polyurethane.

LaCoste discloses a head made out of polyurethane in order to have a hard and impact resistant head (Col. 4 Lns. 23-26). In view of the patent of LaCoste it would have been obvious to have modify the head of Coughlin to have a non-metallic material being made of polyurethane in order to have a hard and impact resistant head.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cook, Solheim, Borah, Minotti and Jacobson disclose a head in which individual members are secured together to make a head body. Shira (5,669,825) discloses a head formed of three segments in which each segment is formed entirely of a homogenous material. Shira (4,992,236) discloses high density heads. Sturm discloses a putter head made of brass. Allen and




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Jepson disclose polyurethane faces. Sadsum discloses a head with three segments in which the toe and heel segments contain metallic material as steel bars.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Jessica Harrison whose telephone number is (703) 308-2217. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.



slb/5/8/98



SEBASTIANO PASSANITI  
PRIMARY EXAMINER  
~~GROUP 3300~~